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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/626,559   | 07/25/2003  | Haruko Toyoshima     | 0445-0339P          | 9344             |
| 2292   | 7590        | 10/16/2006           | EXAMINER            |                  |
| BIRCH STEWART KOLASCH & BIRCH<br>PO BOX 747<br>FALLS CHURCH, VA 22040-0747 |             |                      | HILL, LAURA C       |                  |
|  |             |                      | ART UNIT            | PAPER NUMBER     |
|  |             |                      | 3761                |                  |

DATE MAILED: 10/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/626,559

Applicant(s)

TOYOSHIMA ET AL.

Examiner

Laura C. Hill

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 August 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Response to Arguments*

Applicant's arguments filed 3 August 2006 have been fully considered but they are not persuasive.

In response to Applicant's argument that 'even if the absorbent member of the present invention is arranged nearer to the waist elastic element as in Alemany, the sliding distance in front-to-back diapering becomes large as in Example 2" (see Remarks pages 6-7), Applicant's arguments do not take the place of evidence. *In re Wiseman*, 596 F.2d 1019, 201 USPQ 658 (CCPA 1979); *In re Pearson*, 494 F.2d 1399, 181 USPQ 641 (CCPA 1974). arguments of counsel alone cannot take the place of evidence in the record once an examiner has advanced a reasonable basis for questioning the disclosure. See *In re Budnick*, 537 F.2d at 538, 190 USPQ at 424; *In re Schulze*, 346 F.2d 600, 145 USPQ 716 (CCPA 1965); *In re Cole*, 326 F.2d 769, 140 USPQ 230 (CCPA 1964). Furthermore, Alemany discloses the absorbent member is disposed such that its longitudinal end in the section having fastening tapes 92 is nearer to the waist portion than a centerline, and a width of the absorbent is equal to a minimum width of the absorbent member in the middle crotch portion (figure 1) and also inherently discloses the flexural stiffness values in the ranges claimed since where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established. *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). Moreover, the discovery of a previously

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unappreciated property of a prior art composition, or of a scientific explanation for the prior art's functioning, does not expressly disclose not render the old composition patentably new to the discoverer. *Atlas Powder Co. v. Ireco Inc.*, 190F.3d 1342, 1347, 51 USPQ2d 1943, 1947 (Fed. Cir. 1999). Thus the claiming of a new use, new function or unknown property which is inherently present in the prior art does not expressly disclose not necessarily make the claim patentable. *In re Best*, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977).

In response to Applicant's arguments that "the elastomeric members 76 of Alemany are not provided in a stretched condition" (see Remarks page 8), the limitations on which the Applicant relies (i.e., elastomeric members in a stretched condition) are not stated in the claims. It is the claims that define the claimed invention, and it is the claims, not specifications that are anticipated or unpatentable. *Constant v. Advanced Micro-Devices Inc.*, 7 USPQ2d 1064.

In response to Applicant's arguments that "the prior art fails to appreciate the benefit that results from use of a diaper having all claimed aspects of the invention" (see Remarks page 8), the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

In response to Applicant's arguments that the rejection of claim 5 should be reversed based on the comments based on Alemany (see Remarks page 9), see the discussion above with respect to why Examiner maintains the Alemany rejections.

***Claim Rejections - 35 USC § 102/103***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-4 and 7 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Alemany et al. (US 5,234,423; herein 'Alemany'). Regarding claim 1 Alemany discloses a disposable diaper 20 comprising an absorbent core member 28 positioned between a liquid pervious top sheet 24 and a liquid impervious back sheet 26 (col. 6, ll. 38-42) [Note the containment assembly 22 forms the 'main body' of the diaper-i.e. the top sheet 24, back sheet 26 and core 28]; said diaper 20 having a pair of longitudinal side and end sections each having a side edge, a crotch section located in the area between the longitudinal end sections (col. 6, ll. 63-col. 7, line 2, figure 1), and fastening tapes 42 provided on each side edge of the longitudinal end section (col. 6, ll. 48-51, col. 27, ll. 50-59, figure 1); wherein, the longitudinal end section having fastening tapes 42 has a waist elastic member 34 to form an elastomeric member/extensible waist part 76 (col. 6, line 45, figure 1); the longitudinal end section having fasten fastening tapes 42 with side panel members/extensible side part 90 formed in an area at and below the waist portion (col. 46, ll. 58-68, figure 1); the longitudinal end of the absorbent member 28 having

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fastening tapes 42 is nearer to the waist portion of that section than a centerline 66 that divides the side parts of diaper 20 into equal halves (col. 7, ll. 12-15, figure 1); a width of the absorbent member 28 located between the side parts is greater than the absorbent member width at the crotch section, forming a narrowing hourglass absorbent member (col. 9, ll. 10-16, figure 1). Alemany further discloses there is 30% less absorbency in the front waist region due to the dual layer core (col. 14, ll. 20-27) and further discloses the absorbent article inherently having the absorption capacity ratio, flexural stiffness and elastic length values since when the reference discloses all the limitations of a claim except a property or function, and the examiner cannot determine whether or not the reference inherently possesses properties which anticipate or render obvious the claimed invention but has basis for shifting the burden of proof to applicant as in *In re Fitzgerald*, 619 F.2d 67, 205 USPQ 594 (CCPA 1980). See MPEP §§ 2112- 2112.02.

Alternatively, Alemany does not expressly disclose saturation capacity ratio, absorbent member flexural stiffness, or elastic natural length values. Saturation capacity ratio is a well-known result-effective variable since it is dependent on the amount of absorbent used in the diaper and the end intended use. Flexural stiffness is a result-effective variable since it is dependent on the materials used in the absorbent member, etc. Elastic natural length is a result-effective variable since it is dependent on the size of the waist elastic member. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Alemany with the aforementioned values, since it has been held that discovering an optimum value of a result effective

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variable involves only routine skill in the art. *In re Boesch and Slaney*, 617 F. 2d 272, 205 USPQ 215 (CCPA 1980).

Regarding claim 2 Alemany discloses side panel members/extensible side part 90 may comprise strands of elastomeric materials disposed in the side parts and in waistband 35 and located between the two basal parts of tape fastener 92 (col. 47, ll. 38-46, figure 1).

Regarding claims 3 and 7 Alemany discloses tape tab fastener 92 joined to back sheet 26 and a further comprises a release portion 95 joined to top sheet 24 of diaper 20 (col. 29, ll. 25-26, ll.36-42, figure 1). Alemany further discloses the plurality of elastic members in the side part disposed between the basal parts of the fastener tapes as discussed above with respect to claim 2.

Regarding claim 4 Alemany discloses the two halves of diaper 20 formed by centerline 66 that are substantially equal in size to one another (figure 1).

Claim 1 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kievit et al. (US 4,515,595). Kievit discloses disposable diaper 10 having hourglass shaped absorbent 21 disposed between impermeable back sheet 14 and permeable top sheet 15 and a longitudinal end section having fastening tapes 19 having a waist elastic member 26 provided to form an extensible waist and side parts, said absorbent inherently having about the same absorption capacity ratio in the front and back halves since it is hour-glass shaped and elastic members secured in a contracted state (column 4, lines 22-65, column 6, lines 40-65, column 7, lines 16-20 and lines 50-59, figure 2). Kievit further inherently

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discloses absorption capacity ratio, flexural stiffness and elastic length values since when the reference discloses all the limitations of a claim except a property or function, and the examiner cannot determine whether or not the reference inherently possesses properties which anticipate or render obvious the claimed invention but has basis for shifting the burden of proof to applicant as in *In re Fitzgerald*, 619 F.2d 67, 205 USPQ 594 (CCPA 1980). See MPEP §§ 2112- 2112.02.

Alternatively, Kievet does not expressly disclose saturation capacity ratio, absorbent member flexural stiffness, or elastic natural length values. Saturation capacity ratio is a well-known result-effective variable since it is dependent on the amount of absorbent used in the diaper and the end intended use. Flexural stiffness is a result-effective variable since it is dependent on the materials used in the absorbent member, etc. Elastic natural length is a result-effective variable since it is dependent on the size of the waist elastic member. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Alemany with the aforementioned values, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch and Slaney*, 617 F. 2d 272, 205 USPQ 215 (CCPA 1980).

### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Alemany et al. (US 5,234,423; herein 'Alemany') in view of Breitkopf (US 5,034,008; herein



'Breitkopt') and further in view of McGuire (US 3,312,981). Alemany discloses the waist elastomeric member 76 and side panel members/extensible side part 90 as discussed above with respect to claims 1 and 2. Alemany et al. further discloses the side panel members/extensible side part 90 may comprise polyurethane foams to conform to the waist of the wearer as the wearer sits, stands or moves (col. 47, ll. 53-66, col. 51, ll. 62-67). Alemany *does not expressly disclose* the waist elastic member comprise urethane foam. **Breitkopf** discloses disposable diaper 10 with waist elastic element 28 made of polyurethane foam for enhanced comfort and containment (col. 1, ll. 57-61, col. 5, ll. 66-68, col. 6, ll. 8-18, figure 1). It is well known to those of ordinary skill in the art that polyurethane contributes to contraction and expansibility for use with nether garments as taught by McGuire (US 3,312,981). One would be motivated to modify the waist elastic member of Alemany et al. with polyurethane foam of Breitkopf since both references disclose disposable diapers with waist elastic elements that contract for improved fit. Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to modify the waist elastic member, thus providing a waist elastic member comprising urethane foam.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Buell (US 4,578,071) discloses disposable diaper 10 having hourglass-shaped absorbent core 14 disposed between permeable topsheet 12 and impermeable backsheet 16 with extensible side flaps 22 due to elastic members 26

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extending across the entire waist region width (column 3, lines 40-58, column 4, lines 53-63, figure 1).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura C. Hill whose telephone number is 571-272-7137. The examiner can normally be reached on Monday through Friday (hours vary).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tatyana Zalukaeva can be reached on 571-272-1115. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Laura C. Hill  
Examiner  
Art Unit 3761

LCH



TATYANA ZALUKAEVA  
SUPERVISORY EXAMINER

